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| 09/914,185 | 08/23/2001 | Charles W. Propst Jr | TPP 30482 A | 9479 |
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| Thomas P Pavelko Stevens Davis Miller & Mosher Suite 850 1615 L Street NW Washington, DC 20036 | | EXAMINER BRUENJES, CHRISTOPHER P | | |
| | | ART UNIT PAPER NUMBER 1772 | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/914,185

Applicant(s)

PROPST JR, CHARLES W.

Examiner

Christopher P Bruenjes

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,7,10-13,15-18 and 20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 5,7,10-13,15-18 and 20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

WITHDRAWN REJECTIONS

1. The 35 U.S.C. 102 rejections of claims 1-2, 5-7, 10, 12-13, 15-16, and 18-20 as anticipated by Sugimoto of record in the Office Action mailed April 5, 2004, Pages 4-5 paragraph 8, have been withdrawn due to Applicant's amendments in the Paper filed July 19, 2004.

2. The 35 U.S.C. 103 rejection of claim 5 over Keough in view of Sugimoto of record in the Office Action mailed April 5, 2004, Pages 9-10 Paragraph 11, has been withdrawn due to Applicant's amendments in the Paper filed July 19, 2004.

3. The 35 U.S.C. 103 rejection of claim 7 over Keough in view of Sugimoto and Felter of record in the Office Action mailed April 5, 2004, Pages 10-11 Paragraph 12, have been withdrawn due to Applicant's amendments in the Paper filed July 19, 2004.

REPEATED REJECTIONS

4. The 35 U.S.C. 103 rejections of claims 10-12, 15-17 and 20 over Keough in view of Sugimoto are repeated for the reasons

previously of record in the Office Action mailed April 5, 2004, Pages 9-10 Paragraph 11.

Regarding the newly added limitation to claim 10 that the polymeric composition is in "direct contact" with at least one material selected from the group consisting of paper, fabric and non-woven material, Keough teaches that the antistatic composition is applied to a substrate and then the mixture is contacted with electron radiation (see abstract). One of ordinary skill in the art would have recognized that no intervening layer is needed between the mixture and the substrate, because the mixture is cured directly on the substrate. Keough further teaches that the substrate can be metallized before applying the coating to the metallized or non-metallized side of the substrate (col.4, 1.13-15), therefore one of ordinary skill in the art would have recognized that the coating is applied directly the substrate, whether or not the substrate is metallized.

Regarding the newly added limitations to claim 15 that the coating forms outer layers of the laminate and comprises a polyethylene wax emulsion, Sugimoto teaches the polyethylene wax emulsion and motivation to add it to the coating as stated previously in the Office Action mailed April 5, 2004, Pages 9-10 Paragraph 11. Keough teaches that the coating can be applied

Art Unit: 1772

and cured on both sides of the substrate (col.3, 1.64-66),
therefore the coating forms the outer layers of the laminate.

5. The 35 U.S.C. 103 rejection of claim 18 over Keough in view of Sugimoto and Felter are repeated for the reasons previously of record in the Office Action mailed April 5, 2004, Pages 10-11 Paragraph 12.

Regarding the newly added limitations to claim 15 that claim 18 is dependent on, see above with regards to the repeated rejection for claim 15.

NEW REJECTIONS

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for

Art Unit: 1772

establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw (UPSN 4,379,822) in view of Sugimoto et al (UPSN 5,981,048).

Shaw teaches a paper layer or base coated in direct contact with a conductive polymeric composition or barrier coat consisting of a hydrophobic thermoplastic film-forming resin having labile hydrogen-containing functional groups and a conductive agent, which is a quaternary ammonium compound (see abstract). The film forming resin or colloiddally dispersible film former of the composition is formed of methyl methacrylate/acrylic acid copolymer (col.5, 1.34), which is a methyl methacrylate resin base. The conductive agent is added to the composition in an amount between 2 and 25% based on the weight of the composition (col.7, 1.15-28). The coated paper layer comprises a zinc oxide coating, which is a dispersion of zinc oxide particles onto the barrier coating (col.6, 1.19-40).

Shaw fails to explicitly teach that the conductive polymer composition further comprises a polyethylene wax. However, Sugimoto et al teach that lubricants such as polyethylene wax are added to anti-static films in order to improve film moldability (col.10, 1.1-12). One of ordinary skill in the art would have recognized that a lubricant would be added to a composition that is extruded or molded, in order to improve the film moldability of that composition, as taught by Sugimoto et al.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the applicant's invention was made to add a lubricant such as polyethylene wax to the antistatic composition of Shaw, in order to improve the film moldability of that composition, as taught by Sugimoto et al.

7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keough and Sugimoto et al as applied to claim 10 and in further view of Felter et al (USPN 4,895,886).

Keough and Sugimoto et al taken as a whole teach all that is claimed in claim 10 as shown above, but fail to suggest why the coating further comprises a dispersion of zinc oxide particles. However, Felter et al teach a static dissipative composition including acrylic resin base and quaternary ammonium

Art Unit: 1772

compounds of choline and another quaternary ammonium long chain antistat, in which a dispersion of silica or zinc oxide particles are added in order to stabilize the composition by preventing phase separation of antistatic agents (col.2, 1.63-65). One of ordinary skill in the art would have recognized that both Keough, Sugimoto et al and Felter et al are teaching conductive and static dissipative or anti-static compositions and that zinc oxide particles are added to conductive and static dissipative compositions in order to stabilize the composition by preventing phase separation of the antistatic agents, as taught by Felter et al.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the applicant's invention was made to add a dispersion of zinc oxide particles to the conductive and static dissipative composition of Keough and Sugimoto et al combined, in order to stabilize the conductive and static dissipative composition, as taught by Felter et al.

ANSWERS TO APPLICANT'S ARGUMENTS

8. Applicant's arguments regarding the 35 U.S.C. 102 rejections of claims 5, 7, 10, 12-13, 15-16, 18, and 20 as anticipated by Sugimoto have been considered but they are moot since the rejections have been withdrawn.

9. Applicant's arguments regarding the 35 U.S.C. 103 rejections of claims 5 and 7 over Keough in view of Sugimoto have been considered but they are moot since the rejections have been withdrawn.

10. Applicant's arguments regarding the 35 U.S.C. 103 rejections of claims 10-12, 15-18 and 20 over Keough in view of Sugimoto have been fully considered but they are not persuasive.

Examiner notes that no arguments have been provided directed towards claims 10-12, 15-18 or 20, the arguments are only directed toward claim 5. The rejection to claim 5 has been withdrawn as shown above.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS

of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P Bruenjes whose telephone number is 571-272-1489. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1772

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher P Bruenjes
Examiner
Art Unit 1772

CPB *CPB*
August 26, 2004

Nasser Ahmad
NASSER AHMAD
PRIMARY EXAMINER
Acting SPE 8/27/04